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10/802,492

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Arun K. Chatterjee

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EXAMINER

D'AGOSTA, STEPHEN M

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/802,492

Applicant(s)

CHATTERJEE ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments filed 6-13-2006 have been fully considered but they are not persuasive.

1. The IDS has been considered. Thank you.

2. The USC 112 rejection is NOT overcome. The examiner, in his opinion, is asking a very simple question (eg. please explain the definition of what a supporting network can/can't be). The applicant's answer does not rule out multiple meanings which is exactly what the examiner is trying to avoid/deny. The applicant is asked to reword that term such that it clearly defines what the supporting network must be (eg. change "supporting network" to "cellular network" to rule out PSTN networks and/or digital/IP networks).

3. The applicant argues that Henry does not teach/anticipate the claims. The examiner disagrees since he must give the broadest reasonable interpretation to all claims put before him. The claim states that:

"...sending, to a supporting network, during a process ordinarily used to announce a current location of the mobile station and enable the supporting network to direct incoming calls to the mobile station, a message comprising information distinguishing the message as for activation of the unactivated mobile station.."

The applicant's specification describes this process as follows (page 2):

"...Registration is the process used by a mobile station to announce its current location and to enable the fixed supporting network to direct incoming calls to the appropriate base station. When a mobile station is brought into the operating range of a new BTS the mobile must announce its current location. In order to accomplish this, the mobile station must send a message with its MIN to the new BTS. The MIN is a number assigned to the mobile by the fixed supporting network to enable billing the customer for services and to enable the network to route incoming calls. The MIN must be programmed into the mobile station prior to the first time that the unit is used by the customer. This is called activation. .."

It is the examiner's interpretation that the first time the phone is activated, instead of registering (and sending its location), the phone will instead be activated by the network (which reads on Henry's teachings (eg. activate the

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phone instead of operating as a normal phone which would have sent its location).

It is the examiner's opinion that the applicant can better word/phrase their claims such that they are more specific and do not read on Henry's broad teachings.

4. The applicant argues that claim 30/43 are not taught. The examiner's interpretation of Henry's disclosure reads on the applicant's claim:

With further regard to claim 30/43, Henry teaches that the phone can use an Initial Identification Number (IIN) with which to activate/register the mobile (C5, L61 to C6, L10). Since the phone would register first, along with using a non-activated MIN (eg. the IIN), the mobile would inherently comprise information that distinguishes itself from an ordinary registration order since the network will recognize the IIN and cause the phone to be connected to the service provider/over the Air server for activation.

5. In response to applicant's arguments against the references individually (eg. Henry and Bhagat for claims 26, 39, 42 and 43), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Firstly, Henry shows that there is means for activating a phone while Bhagat shows an operation whereby the mobile phone would be able to register within the network as a roamer.

Furthermore, the examiner notes that it is indeterminate as to "exactly when" (eg. before, during or after the activation and/or registration) that claim 26 is actually invoked/performed. The applicant is invited to amend their claims to be more precise.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 26, 39 and 42-43** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is confused by the term “supporting network”. It is a broad term which can be viewed as either a home or visited network but it does not stipulate which one it is (?). Supporting network in claims 21 and 31 can be viewed as a “home network” but claims 26 and 39 teach data being stored in a VLR which infers the mobile is not located in a home network (?). Please clarify.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 21-25, 27-38 and 40-41** rejected under 35 U.S.C. 102(e) as being anticipated by Henry et al. US 5,603,084.

As per **claims 21, 31 and 43**, Henry teaches an unactivated mobile station programmed to perform a method (C6, L42-48 teaches “activating” an unactivated phone) comprising:

sending to a supporting (*eg. local*) network, during a process ordinarily used to announce a current location of the mobile station and enable the supporting network to direct incoming calls to the mobile station, a message comprising information distinguishing the message as for activation of the unactivated mobile station (C5, L51 to C6, L48 teaches activation of a mobile phone while C6, L42 to C7, L12 teaches an unactivated phone having a Boolean variable which will cause an un-programmed phone to initiate the activation process, see C6, L60-67. The examiner notes that Henry does not teach announcing a current location of the mobile during the activation but rather states that the un-programmed phone will perform the activation process first, which means that it does it instead of performing a current location operation which is typical for a registered phone. Furthermore, C7, L3-11 teaches sending data between phone and network but current location information is not explicitly listed); and

receiving activation parameters sent from the supporting network responsive to the message comprising the information distinguishing the message as for activation of the unactivated mobile station (C7, L50-58 teaches the network sending activation data to the phone. Also see C7, L25-30 which teaches an unblocked activation number which is the only number an unactivated mobile can call).

***With further regard to claim 30***, Henry teaches that the phone can use an Initial Identification Number (IIN) with which to activate/register the mobile (C5, L61 to C6, L10). Since the phone would register first, along with using a non-activated MIN (eg. the IIN), the mobile would inherently comprise information that distinguishes itself from an ordinary registration order since the network will recognize the IIN and cause the phone to be connected to the service provider/Over the Air server for activation.

As per **claims 22 and 34**, Henry teaches claim 21/30 wherein the information distinguishing the message as for activation of the unactivated mobile

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station comprises an over-the-air activation function number (C7, L3-11 teaches an "information function" which may include account information, etc.. The examiner interprets the information function coupled with the account information to read on an activation function number).

As per **claims 23, 25, 35 and 37**, Henry teaches claim 21/30 wherein the information distinguishing the message as for activation of the unactivated mobile station comprises a dummy mobile identity number (C7, L20-23 teaches the phone providing an IIN number which is a dummy MIN number. Also see C5, L34 to C6, L10).

As per **claims 24 and 36**, Henry teaches claim 21 wherein the information distinguishing the message as for activation of the unactivated mobile station comprises a routing address (eg. phone number) of an over-the-air activation processor (C6, L55-60 teaches dialing an address/phone number from the phone which calls the activation service).

As per **claims 27 and 40**, Henry teaches claim 21/30 wherein the activation parameters comprise number assignment module parameters (C7, L59-60 teaches the network determining a MIN for the phone and sending it to the mobile. The network inherently uses a software module to determine and assign the MIN number).

As per **claims 28 and 41**, Henry teaches claim 21/30 wherein the activation parameters comprise a telephone number for the unactivated mobile station (C7, L59-60 teaches the network determining a MIN for the phone and sending it to the mobile).

As per **claims 29 and 31**, Henry teaches claim 21/30, further comprising:

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storing the activation parameters in memory within the inactivated mobile station (C6, L21-33 teaches sending the MIN to the mobile and said mobile storing it in memory).

As per **claims 32-33**, Henry teaches claim 30 wherein activating the mobile station comprises enabling the mobile station to send and receive voice communications via the supporting network AND to other mobiles (C6, L8-10 teaches programming the phone with a MIN which inherently allows the phone to then make voice calls, since it can now be registered. Also see C8, L39-45 teaches the phone is "operational").

As per **claim 38**, Henry teaches claim 30 wherein the message comprises a serial number of the mobile station (C5, L50 to C6, L10 teaches the IIN being a portion of the Electronic Serial Number).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 26, 39 and 42-46** rejected under 35 U.S.C. 103(a) as being unpatentable over Henry and further in view of Bhagat et al. US 5,414,750.

As per **claims 26 and 39**, Henry teaches claim 21 **but is silent on** wherein the message comprises a serial number of the mobile station for recording in a visitor location register of the supporting network.

Bhagat teaches..... In the operation of a system of roaming using the IS-41 standards, a roamer is required to register in a visited carrier system. The registration may be initiated directly by the roamer, or a mobile telephone



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switching office (MTSO) of a visited carrier system may detect the roamer's presence from a call initiated by the roamer, a call completed to the roamer, or through a request for service. Once the registration has been initiated, the visited MTSO notifies its associated VLR that the roamer has registered. The VLR then sends a registration notification message to the HLR associated with the roamer's home carrier system. The message sent by the VLR is routed according to the roamer's MIN.

The examiner notes that when the roamer registers in a visited carrier system, this inherently requires specific data about the mobile to be stored in the VLR, including the MIN and/or ESN.

It would have been obvious to one skilled in the art at the time of the invention to modify Henry, such that the message comprises a serial number of the mobile station for recording in a visitor location register of the supporting network, to provide means for the VLR to support the mobile during activation.

As per **claim 42**, Henry teaches an unactivated mobile station programmed to perform a method comprising;

sending, to a fixed supporting network, during a process ordinarily used to announce a current location of the mobile station and enable the fixed supporting network to direct incoming calls to the mobile station (C5, L51 to C6, L48 teaches activation of a mobile phone while C6, L42 to C7, L12 teaches an unactivated phone having a Boolean variable which will cause an un-programmed phone to initiate the activation process, see C6, L60-67. The examiner notes that Henry does not teach announcing a current location of the mobile during the activation but rather states that the un-programmed phone will perform the activation process first, which means that it does it instead of performing a current location operation which is typical for a registered phone. Furthermore, C7, L3-11 teaches sending data between phone and network but current location information is not explicitly listed), a message having a format of an ordinary

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registration order comprising information distinguishing the message as for activation of the unactivated mobile station and wherein the message does not comprise a valid mobile identity number (C5, L61 to C6, L10 -- Since the phone would register first, along with using a non-activated MIN (eg. the IIN), the mobile would inherently comprise information that distinguishes itself from an ordinary registration order since the network will recognize the IIN and cause the phone to be connected to the service provider/Over the Air server for activation); and

receiving number assignment module activation parameters sent from the fixed supporting network originating from art activation process initiated in an over-the-air activation processor responsive to the message comprising the information distinguishing the message as for activation of the unactivated mobile station (C6, L21-33 teaches sending the MIN to the mobile and said mobile storing it in memory)

**But is silent on**

wherein the message comprises an electronic serial number of the unactivated mobile station for recording in a visitor location register of the fixed supporting network.

Bhagat teaches..... In the operation of a system of roaming using the IS-41 standards, a roamer is required to register in a visited carrier system. The registration may be initiated directly by the roamer, or a mobile telephone switching office (MTSO) of a visited carrier system may detect the roamer's presence from a call initiated by the roamer, a call completed to the roamer, or through a request for service. Once the registration has been initiated, the visited MTSO notifies its associated VLR that the roamer has registered. The VLR then sends a registration notification message to the HLR associated with the roamer's home carrier system. The message sent by the VLR is routed according to the roamer's MIN.

The examiner notes that when the roamer registers in a visited carrier system, this inherently requires specific data about the mobile to be stored in the VLR, including the MIN and/or ESN.

It would have been obvious to one skilled in the art at the time of the invention to modify Henry, such that the message comprises an electronic serial number of the unactivated mobile station for recording in a visitor location register of the fixed supporting network, to provide means for the VLR to support the mobile during activation.

As per **claim 43**, Henry teaches a mobile switching center programmed to perform (figure 1 shows an MSC #22 connecting mobiles #30 to the activation center #27) a method comprising:

receiving, from a mobile station, an activation message having a format of an ordinary registration order, wherein the activation message comprises information distinguishing the activation message from an ordinary registration order (Henry teaches that the phone can use an Initial Identification Number (IIN) with which to activate/register the mobile (C5, L61 to C6, L10). Since the phone would register first, along with using a non-activated MIN (eg. the IIN), the mobile would inherently comprise information that distinguishes itself from an ordinary registration order since the network will recognize the IIN and cause the phone to be connected to the service provider/Over the Air server for activation); and

**but is silent on**

storing, in a record in a visitor location register associated with the mobile switching center, at least some of the information distinguishing the activation message from an ordinary registration order.

Bhagat teaches..... In the operation of a system of roaming using the IS-41 standards, a roamer is required to register in a visited carrier system. The registration may be initiated directly by the roamer, or a mobile telephone switching office (MTSO) of a visited carrier system may

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detect the roamer's presence from a call initiated by the roamer, a call completed to the roamer, or through a request for service. Once the registration has been initiated, the visited MTSO notifies its associated VLR that the roamer has registered. The VLR then sends a registration notification message to the HLR associated with the roamer's home carrier system. The message sent by the VLR is routed according to the roamer's MIN.

The examiner notes that when the roamer registers in a visited carrier system, this inherently requires specific data about the mobile to be stored in the VLR, including the MIN and/or ESN.

It would have been obvious to one skilled in the art at the time of the invention to modify Henry, such that it stores in a record in a visitor location register associated with the mobile switching center, at least some of the information distinguishing the activation message from an ordinary registration order, to provide means for the VLR to support the mobile during activation.

As per **claim 44**, Henry teaches claim 43 **but is silent on** wherein the at least some portion of the information distinguishing the activation message from an ordinary registration order that is stored in the visitor location register record serves as routing information for use in routing activation data to the mobile station

Bhagat teaches..... a roamer is required to register in a visited carrier system. The VLR then sends a registration notification message to the HLR associated with the roamer's home carrier system. The message sent by the VLR is routed according to the roamer's MIN.

The examiner notes that when the roamer registers in a visited carrier system, the VLR inherently stores specific data about the mobile, including the location of the mobile in that network which is used to route data/calls.

It would have been obvious to one skilled in the art at the time of the invention to modify Henry, such that the at least some portion of the information

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distinguishing the activation message from an ordinary registration order that is stored in the visitor location register record serves as routing information for use in routing activation data to the mobile station, to provide means for the VLR to support the mobile during activation.

As per **claim 45**, Henry teaches claim 43 wherein the information distinguishing the activation message from an ordinary registration order comprises a dummy mobile identity number (C7, L20-23 teaches the phone providing an IIN number which is a dummy MIN number. Also see C5, L34 to C6, L10).

As per **claim 46**, Henry teaches claim 43 wherein the activation message comprises at least a portion of an electronic serial number of the mobile station (C5, L50 to C6, L10 teaches the IIN being a portion of the Electronic Serial Number).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEVE M. D'AGOSTA  
PRIMARY EXAMINER

*[Signature]*  
7-21-06